

Ref.: EMR 100 A 1 [12452.03587]

PATENT

AF \$
3728

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Merel Epstein
Serial No: 09 / 603,222
Filing Date: June 26, 2000

Group Art Unit: 3728
Examiner: Jila Mohan

RECEIVED
OCT 22 2001
TECHNOLOGY CENTER R3700

Title: **BALANCING APPLIANCE FOR FOOTWEAR ITEM**

CERTIFICATE OF MAILING AND TRANSMITTAL LETTER

Attn: Box Patent Office Board of Patent Appeals
Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Transmitted herewith are the following: (1) "Appellant's Brief Under 37 CFR 1.192" – in triplicate; (2) this "Certificate of Mailing and Transmittal Letter"; and (3) a self-addressed, Stamped Postcard.

_____ No additional fee is required

_____ Our Check in the amount of _____ is attached.

X Charge \$155.00 to Deposit Account No. 50-0404.

X Please charge any additional fees or credit overpayment to Deposit Account No. 50-0404.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents and Trademark, Washington, D.C. 20231 on this 13 day of October, 2001.

PLUNKETT & COONEY, PC
38505 Woodward, Suite 3000
Bloomfield Hills, MI 48304
248 / 901 – 4000

Charles D. Loefer

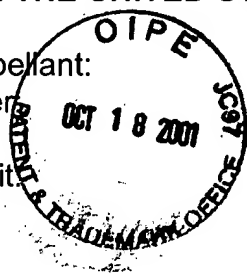
Attorney Reference: EMR 100 A 1 [12452.03587]
D12:U:R:10/13/01:P:10/13/01

PATENT

#13
Brief
E. Epstein
10/24/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant/Appellant:
Serial Number:
Filing Date:
Group Art Unit:
Examiner:



Merel Epstein
09 / 603,222
June 26, 2000
3728
Jila Mohandesi

TECHNOLOGY CENTER
R3700

OCT 22 2001

RECEIVED

Title:

BALANCING APPLIANCE FOR FOOTWEAR

APPELLANT'S BRIEF UNDER 37 CFR 1.192

Attn: **Board of Patent Appeals and Interferences**
Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This Appeal Brief is in completion of the "Notice of Appeal" Applicant filed on August 15, 2001.

This Appeal Brief is submitted in triplicate.

This Appeal Brief contains these items under the following headings and in the order set forth below, as required by 37 CFR 1.192 (c):

1. Real Party in Interest
2. Related Appeals and Interferences
3. Status Of Claims
4. Status of Amendments
5. Summary of Invention
6. Issues
7. Grouping of Claims
8. Arguments
9. Appendix of Claims Involved in the Appeal

The final page of this Appeal Brief bears the Attorney's signature.

10/22/2001 AWONDAF1 00000060 500404 09603222

01 FC:220 160.00 CH

1. Real Party in Interest

The real party in interest is the above named Applicant/Appellant.

2. Related Appeals and Interferences

There are no other appeals or interferences known to Appellants' legal representative.

3. Status Of Claims

Claims 1, 7, and 8 remain pending in this Application and are part of this Appeal.

4. Status of Amendments

In an Office action (Paper No. 8, dated May 11, 2001), the Examiner applied a final rejection ("the "Final Action") to Claims 1, 7, and 8, the only claims pending in the application.

In response, Applicant filed a timely "Reply After Final Under 37 CFR 1.116" and a "Notice of Appeal" (date stamped August 15, 2001). In the Reply, Applicant: (a) submitted a new "Terminal Disclaimer" to obviate a defective "Terminal Disclaimer", and (b) responded as follows: as to the pending Claims 1, 7, and 8: entry of amendments to Claim 1 was requested, Claims 7 and 8 were not amended, the Examiner's rejections of Claims 1, 7, and 8 were traversed, and reconsideration was requested.

In an "Advisory Action" (Paper No. 12, dated August 29, 2001), the Examiner: (a) entered the new Terminal Disclaimer and withdrew a double patenting rejection, (b) reiterated a belief that a previously submitted Affidavit under 37 CFR 1.132 was unpersuasive, and (c) refused entry of the requested amendments to Claim 1, stating that the amendments either raised new issues and/or did not reduce or simplify the issues for appeal.

This Appeal Brief is filed in response to the Advisory Action (Paper No. 12).

5. Summary of Invention:

The invention is directed to a universal balancing disc for providing balance and weight distribution adjustment, which is easily integrated with existing orthotic foot devices as well as into other footwear items or devices. Such disc overcomes the time consuming minute corrections previously required by the practitioner. Desirably, these discs are available to the practitioner in "kit" form to select a specifically configured disc to effect a proper fitment. As exemplified in the allowed claims of Applicant's United States Patent 6,098,319, the subject of the "Terminal Disclaimer" herein, the invention is characterized in Claim 1 thereof by a kit of discs for balancing the gait of a user:

the kit comprising: a plurality of the discs, each disc comprising a substantially rigid, circular wedge member having an planar upper surface and a planar lower surface, the upper and lower surfaces being angularly inclined with respect to each other by an angle of about 2° to about 6°, the disc being attachable to a footwear item and being rotatable through a 360° arc to enable incremental balancing adjustment for imparting proper weight distribution and balance to the user, and
wherein the discs have varying angles of inclination.

The invention is further characterized by:

2. The balancing disc of claim 1 wherein the discs are formed of a solid material which is either a rigid foam, steel, or plastic.

The invention of this Appeal is directed to a balancing disc for securement to an orthotic foot device. In particular, Claim 1 of this Appeal is directed in part to an orthotic disc that is "securable to the orthotic foot device in a plurality of incremental orientations through 360° to effect a desired balance and weight distribution". Further Claims 7 and 8 of this Appeal are directed in part to "a substantially rigid, circular, wedge member

having a planar upper surface and planar lower surface, the upper and lower surfaces being angularly inclined with each other by an angle θ of about 2° to 6°.

The previously allowed claims in United States Patent No. 6, 098, 319 are directed to a kit of orthotic discs – and the claims in the instant appeal are directed to the discs - as defined by the claims in the '319 patent. As such, the claims herein are believed to be patentable for the same reasons as those in Applicant's previously allowed patent.

6. Issues:

The Affidavit is unpersuasive in part because it is directed to the method of intended use of the claimed disc, which does not distinguish over the prior art.

Claims 1, 7, and 8 stand rejected under 35 USC Section 112, second paragraph, as being indefinite.

Claims 1, 7, and 8 stand rejected under 35 USC § 103(a) as being unpatentable over combinations of prior published patents to Kantro (USPN 5,170,572), Cherniak (USPN 3,099,267), Shaw (USPN 1,958,097), Smith (USPN 5,345,701), and Marc (USPN 5,068,983).

7. Grouping of Claims

Claims 1, 7, and 8 are to be considered as one group of claims, rising and falling together.

8. Arguments

Applicant's Attorney contends that:

(1) The Affidavit herein is sufficient to overcome the rejection of Claims 1, and 7 – 8 based on Kantro, Cherniak, Shaw, Smith, and Marc.

(2) The Examiners rejection of Claims 1, 7, and 8 under 35 USC Section 112, second paragraph, as being indefinite, is incorrect and should be removed.

(3) The Examiner's rejection of Claims 1, 7, and 8 under 35 USC Section 103 (a) as being obvious in view of various combinations of prior published patents, and thus unpatentable, is based on an impermissible hindsight reconstruction and these rejections should be reversed.

(4) Claims 1, 7, and 8 are patentable over the prior art references of record and in condition for allowance.

Affidavit Under 37 CFR 1.132

The Examiner contends that the Affidavit filed March 12, 2001 is insufficient to overcome the rejection of Claims 1, and 7 – 8 based upon Kantro, Cherniak, Shaw, Smith and Marc as set forth in the Final Action (discussed herein below) because:

“Complementary anecdotes do not overcome evidence of anticipation and obviousness well established by the prior art. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to overcome the evidence of obviousness.”

Applicant's Attorney **strongly disagrees** with the weight afforded the Affidavit and the Examiner's characterization of the statements provided therein as being “anecdotes”.

The MPEP directs Examiner's to consider Affidavits from those skilled in the art opining that the prior art teaches away from the invention. Importantly, it is improper to combine references where the references teach away from the combination. *In re*

Gresselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983), MPEP Section 2145, page 2100-123 (Rev. 1, Feb. 2000).

The Affidavit herein presents the opinion of an Affiant having more than twenty (20) years experience in designing, selling and manufacturing orthotic devices. Affiant is a highly experienced practitioner in the art of orthotics and the statements in the Affidavit are not merely anecdotes.

Affiant stresses that the invention herein is not a cushion, but rather, an insert that is made of a hard, rigid material that does not compress but which retains its shape to provide a biomechanical control for balance. All of the claims herein are directed to a balancing disc for securement to an orthotic device. The disc of independent Claim 1 comprises a substantially circular wedge shaped member that is securable in a plurality of incremental orientations through 360° to effect a desired balance and weight distribution. In independent Claim 7, the disc is a substantially rigid wedge shaped member, the surfaces being inclined at an angle of 2° to 6°, and attachable for imparting proper weight distribution.

Affiant points out that to those skilled in the art of orthotics, there is a difference between balancing and cushioning. A cushion can never impart balance, as the word "cushion" implies a collapse of the structure or a flexure of the body of the device. A cushion is used to accommodate – not provide control.

The Examiner reconstructed Kantro with Cherniak, or with Marc, Smith and Shaw, to find Applicant's claimed invention as being obvious under 35 USC Section 103. Affiant analyzed and distinguished the primary reference [Kantro] relied upon by the Examiner as follows:

"[Kantro] discloses a method for attaching cushions in specific locations to provide tripodal support ... to accommodate the foot, as opposed to applicant's claimed invention which provides a hard, rigid, plastic material insert that provides a biomechanical control for balance."

In short, Kantro teaches away from Applicant's claimed invention.

Additionally, Affiant further distinguishes the invention and Kantro. First Affiant notes that the disc of the invention is capable of being rotated 360° such that the foot can be balanced by the eversion or inversion of the insole, by attachment of the inserts to the insole at any necessary locations to impart balance (see Claim 1). Note in Kantro that three differently configured discs (19, 20, and 21) are tripodally located at three different but specific locations and each configured disc disposed in a specific angular orientation relative to predetermined portions of the foot and relative to axes through the foot device. That is, Kantro teaches the provision of three differently configured discs (19, 20, and 21), and that each of the three discs be fixed spatially and angularly relative to the foot. Kantro teaches away from angular positioning of orthotic discs (19, 20, and 21).

Second, Affiant notes that the disc of the invention defines a circular wedge having an angle between upper and lower surfaces thereof within the range of 2° to 6° (see Claims 7 – 8). Affiant submits that Kantro discloses a wedge shaped circular cushion, but does not disclose or remotely suggest the 2° to 6° range of the balancing disc of the invention. This range provides a limitation to the angle of wedges and is capable of imparting balance to about 90% of the fore foot and rear foot encounters. In short, the importance of the range is not obvious.

Accordingly, Applicant's Attorney submits that the Examiner has not given the Affidavit herein the proper weight required to be given to rebuttal evidence of nonobviousness as detailed in the Declaration.

The Affidavit must be considered and given significant weight in the obviousness determination mandated by *Graham*. So considered, the Examiner's combination of references is thus seen as flawed.

Claim Rejections: 35 USC 112, ¶ 2

Claims 1, 7, and 8 stand rejected under 35 USC 112, second paragraph, as being indefinite. In Paragraphs 5 and 6 of the Action, the Examiner contends that:

In Claim 1, the phrase "the disc being securable to the orthotic foot device in a plurality of incremental orientations through 360° to effect a desired balance and weight distribution" is vague and indefinite. It is not clear what structure this limitation would encompass.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 120 USPQ 528, 531. Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb* (sic) 15 USPQ 2d 1525, 1528. See MPEP 2114.

Applicant's Attorney traverses the Examiner's rejection.

The invention is directed to a universal balancing disc for providing balance and weight distribution which is easily integrated with existing orthotic foot devices as well as into other footwear items or devices. Such disc overcomes the time consuming minute corrections previously required by the practitioner. The phrase "the disc being securable to the orthotic foot device in a plurality of incremental orientations through 360° to effect a desired balance and weight distribution", is believed specific, definite, and clear as to what structure this limitation would encompass. This language is

commensurate with the language used in the claims of Applicant's parent United States Patent No. 6,098,319 and defines the securement over the prior art.

According to the invention herein, a substantially rigid circular disc is particularly adapted to be securable to an orthotic foot device, both in posterior and anterior portions of the orthotic device. The disc of Claim 1 is wedge-shaped and has a planar top and bottom surfaces, the surfaces being inclined at an angle with respect to each other, and one of said surfaces being securable to the orthotic foot device at a desired location of said foot device. The wedge shape of the disc is securable to the orthotic foot device in a plurality of incremental orientations through 360° to effect a desired balance and weight distribution or provide the requisite adjustment for effecting proper balance and weight distribution. (Specification, page 5, lines 24+).

Claims 7 and 8 do not include the phrase of Claim 1 that the Examiner found to be vague and or indefinite. Accordingly, Claims 7 and 8 are submitted as being neither indefinite nor vague, as meant by 35 USC Section 112, Paragraph 2.

The *Danly* and *Hewlett-Packard* cases, while of interest, are not believed relevant to the claims herein and the rejection under 35 USC Section 112, Paragraph 2. The relied upon passages from *Danly* ("apparatus claims cover what a device is, not what a device does") and *Hewlett-Packard* ("apparatus claims cover what a device is, not what a device does") are believed taken out of context or at best dicta.

Danly involved an appeal from the POBA of Claim 1, which claim was directed to a press structure in which "alternating current may be passed through the tie rod to heat same." The CCPA noted that the quoted passage did not constitute a structural limitation. That is not the case with the claims pending herein.

Hewlett-Packard (“H-P”) involved an appeal by Bausch & Lomb (“B&L”) from a decision upholding the validity and infringement of patent Claim 1, which claim was directed to an X-Y plotter system wherein one of a drive and idler surface had “a rough surface”. Although H-P disclosed the use of “grit”, the last clause of Claim 1 recited, “wherein the rough surface ... has a random pattern, size, and height of rough spots.” B&L argued that the recited phrase does not provide any “operational difference” over a knurled wheel (shown in the prior art) and thus does not render the claim unobvious thereover. In effect, B&L wanted to import a limitation into the claim from the specification onto claim language. The CAFC rejected B&L’s argument that H-P had to show “operational differences” of the claimed device over the prior art.

Independent Claims 1 and 7 are not properly rejected under either *Danly* or *Hewlett-Packard*. First, each of the elements required in each of Applicant’s claims, while having a specific structure and function, constitute definite structural limitations. As in *Hewlett-Packard*, the elements of the claims herein recite structure, which is used in a particular manner, albeit operating in a manner that is different from the prior art. The elements recited do not simply cover what the device does and the claim language is neither vague nor indefinite. Second, these structural limitations define over the references of record.

Claim Rejections: 35 USC Section 103 (a)

Claims 1, and 7 – 8 stand rejected under 35 USC Section 103(a) as being unpatentable over Kantro (USPN 5,170,572), in view of Cherniak (USPN 3,099,267).

In Paragraphs 7 and 8 of the Final Action, the Examiner contends (at page 4) that Kantro ‘572 teaches substantially all the limitations of the claims, arguing that

circular element 20 is of high density polymeric foam material and tapered at about 5 degrees, that Cherniak '267 teaches that foot balancing devices 50, 52, and 54 may be rigid or yieldable, and concludes that it would have been obvious to one having ordinary skill in the art and in view of Cherniak '267 to make the circular element 20 of Kantro '572 more rigid or sufficiently rigid to ensure better support and weight distribution.

Claims 1, and 7 – 8 stand rejected under 35 USC Section 103(a) as being unpatentable over Kantro, in view of Cherniak, Shaw (USPN 1,958,097), Smith (USPN 5,345,701, and Marc (USPN 5,068,983).

The Examiner contends on page 5 of the Final Action that Shaw, Smith, and Marc references are relied upon “for purposes of argument any doubt should subsequently be raised concerning the language in Kantro '572. ... These references both individually and collectively are representative of corrective wedge members having upper and lower surfaces angularly inclined by a small angle greater than zero (in the range of about 2 to 5 degrees) which are used with insoles and orthotics to enhance or correct biomechanical balance and weight distribution.” In general, the Examiner contends that the orthotic disc can have a taper angle as desired and be secured to the insole with an orientation relative thereto as desired.

Applicant's Attorney traverses both of the Examiner's multi-reference rejections. Whether considering the references alone, or the combination of two references (Kantro and Cherniak), or the combination of five references (Kantro, Cherniak, Shaw, Smith and Marc), the references do not show, suggest, or provide a motivation for the combination proposed by the Examiner.

When prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art must suggest the desirability, and thus the obviousness, of making the combination. It is impermissible within the framework of 35 USC Section 103 to pick and choose from any one reference only so much of it as will support a given position to the full exclusion of other parts necessary for the full appreciation of what such reference fairly suggested to one of skill in the art.

The Examiner's combination is a pure hindsight reconstruction of the prior art. Applicant's Attorney submits that the prior art relied upon by the Examiner does not render Applicant's claims obvious.

As will be developed more fully herein, the prior art does not render the claimed invention obvious under 35 USC Section 103(a) because:

(a) the prior art teaches away from a rigid circular wedge shaped disc member of the invention herein (Claims 1, and 7 - 8) by teaching the use of compressible cushions; and/or

(b) the prior art does not teach or suggest either that (1) a disc member be securable to the foot device at a desired location of the foot device and the wedge shape of the disc angularly oriented at any desired angle through a plurality of incremental rotations through 360° to effect a desired balance and weight distribution (Claim 1), or that (2) a disc member have a specific angle of inclination of between 2° to 6°.

Inappropriateness of the reconstruction of Kantro with either or all of Cherniak, and Smith, and Shaw, and Marc is resolved in favor of nonobviousness, as supported by the "Affidavit Under 37 CFR 1.132" (the "Affidavit") herein from one having twenty years of experience in the art

X Kantro, Shaw, Smith and Marc are all directed to cushions. A cushion can never impart balance. Applicant's claimed invention is not a cushion but rather a rigid circular wedge-shaped orthotic device providing biomechanical control for balance.

As stated in the Affidavit, as understood by one having skill in the art, there is a difference between balancing a gait and cushioning. The word "cushion" implies a collapse of the structure or a flexure of the body of the device. A cushion is used to accommodate, rather than provide biomechanical control.

Kantro teaches that three specifically configured cushions (19, 20, and 21) be comprised of a polymeric foam material and be placed at specific locations (11, 12, and 13) of a shoe insert to form an obtuse triangle to provide tripodal support:

"As weight increases and its distribution on the body changes, more cushioning is required to lessen shock to the foot, also support at the gait points to permit the foot to maintain its proper posture as well as to alleviate stress and strain upward through the legs and into the lower back caused by improper foot posture." (col. 4, lines 35 – 41)

Kantro teaches that more cushioning is required to lessen shock. This is consistent with the Affidavit - a cushion can never impart balance. Kantro does not teach and does not suggest the provision of a rigid circular member to provide control in balancing the gait of a user. Contrary to Claims 7 – 8 herein, Kantro teaches away from a rigid disc.

Further, in Kantro, the three locations (11, 12, and 13) of the shoe insert dictates the provision of three differently configured cushions (19, 20, and 21) and also requires

that the geometry of each cushion (19, 20, and 21) have a specific angular orientation relative to the other discs and axes through the foot insert. In particular, Kantro teaches:

"To further mitigate the tendency towards pronation, cuboidal cushion 20 is also tapered along (sic) an axis directed at an angle relative to the longitudinal axis of the insole along line 20a toward the gait point located at the base of the first metatarsal bone 9a and the metatarsal cushion 21. This corresponds to the direction of force along line 12a in FIG. (sic) from the calcaneal-cuboid gait point to the first metatarsal gait point 13." (col. 4, lines 44 – 52)

The rotational positioning of cuboidal cushion 20 is such that the taper is angled relative to the longitudinal axis of the insert and the foot toward the base 13 of the first metatarsal bone 9a and the metatarsal cushion along line 20a." (col. 5, lines 37 – 41)

Contrary to Claim 1, Kantro teaches against the provision of:

a substantially rigid, circular wedge-shaped member ... securable to the orthotic foot device at a desired location of said foot device and the wedge shape of the disc angularly oriented at any desired angle from 0° to 360° about a vertical axis through the center of the disc to effect a desired balance and weight distribution.

The orthotic disc of the claimed invention is securable to the foot insert at a desired location and angle relative to a vertical axis to effect a desired balance and weight distribution. Kantro teaches against the requirements of Claim 1.

Cherniak is directed to a foot balancing device comprising, inter alia, a first, second, and third set of circular pads (50, 52, and 54), each pad preferably being of uniform thickness, and, rigid or yieldable. (See FIG. 9, and col. 2, lines 1 –2, and col. 4, lines 6 – 9). Cherniak teaches:

"In all cases, the function of the pads is to lift the weight of the foot off the metatarsal heads so that the weight is balanced on the pads independently of the structural deformation of the skeletal foot and/or imbalance produced by callouses and the like on the bottom of the foot." (col. 4, lines 6 – 9)

Cherniak does not teach provision of a wedge shaped orthotic disc to effect a desired balance and weight distribution.

In Cherniak, the pads are flat and circular and function to lift the weight of the foot. Indeed, Cherniak teaches that to achieve the lifting function, a continuous array of

pads is required and that these pads be placed side-by-side. Cherniak certainly does not suggest that the pads be wedge shaped because the wedges with inclined faces would not provide the desired lifting function. Further, the orientation of the wedge-shapes in the array is not clear, as regards the effect on the foot. Clearly, Cherniak teaches against a wedge-shape pad that is oriented relative to a foot insert onto which secured.

The combination of Kantro in view of Cherniak is not believed to render Claim 1 obvious under 35 USC Section 103 (a). Kantro discloses very specific cushion structure and a cushion system that operates differently than that required by Applicant's claims herein, and as such, does not suggest or provide motivation for reconstruction with Cherniak. Kantro teaches against a rigid circular wedge shaped member, securable to a foot device at a desired location of the foot device and the wedge shape of the wedge shape of the disc incrementally oriented so as to be at any desired angle from 0° to 360° about a vertical axis through the center of the disc. To the extent that one of the three discs of Kantro is tapered (viz., disc (20)), the Kantro disc is not rigid, forms one vertex of an obtuse triangle and is fixed relative to the foot insert, and the wedge shape is aligned along an axis that is at an angle to the longitudinal axis of the insert. Notwithstanding the Examiner's combination of Kantro with Cherniak, Kantro teaches against angular positioning of the discs (19, 20, and 21) about a vertical axis through the disc from 0° to 360°. Indeed, according to Kantro, "To further mitigate the tendency towards pronation, cuboidal cushion 20 is also tapered alone (sic) an axis directed at an angle relative to the longitudinal axis of the insole. As to the secondary reference, Cherniak teaches the provision of an array of pads of

uniform thickness to provide a lifting function, the pads being rigid or yieldable. It is irrelevant how a flat circular disc of uniform thickness is oriented relative to a vertical axis therethrough.

At best, the combination of Kantro with Cherniak would provide a combination wherein the Kantro disc (20) is rigid, and of uniform thickness. To simply redesign the tapered disc (20) of Kantro in a vacuum is to ignore the teaching and function of the pads in either of the Kantro and Cherniak references. A prior art reference that diverges from and points in a direction away from the invention is evidence that the invention is nonobvious and hence patentable.

Whether considered alone, or in combination, Kantro and Cherniak do not teach or suggest the requirements of Claim 1.

Accordingly, Claim 1, as amended is submitted as being patentable over the prior art references of Kantro and Cherniak.

As to the combination of Kantro, and Cherniak, and Shaw, and Smith, and Marc, the Examiner relied on these references as teaching the provision of wedge shaped members: Shaw for inclined wedge members having a tapered portion of about 3°, Marc for a base piece (20) having a tapered portion of 2°, and Smith for correcting wedges (24, 26) tapered at about 4°, concluding that the wedges can be formed at any angle, depending upon the patient's needs.

Applicant's Attorney traverses the Examiner's reliance on these references as being a hindsight reconstruction by using Applicant's claims as a roadmap to find prior art having a needed feature. Each reference had a specific problem and disclosed a specific solution.

Kantro fixes the locations, the geometries, and the angular orientations of three differently configured cushions relative to longitudinal axes passing through the foot device. The reason for the tripodal placement and specific cushion orientation was critical and particularly described by Kantro. Kantro was faced with a specific problem and disclosed a specific solution the Examiner's rejection required the addition of Cherniak – for a pad of uniform thickness. These references are then added to show taper angles. The overall combination does not support a finding of obviousness under the factual mandates of 35 USC Section 103 (a).

Shaw, Marc and Smith do not show and do not suggest a wedge-shaped orthotic disc that is incrementally positionable (i.e., angularly orientable) at any angle from 0° to 360° about a vertical axis through the disc. These references teach away from the wedge shaped corrective pads being circular or orientable through 360°, as required by Claim 1.

Shaw and Smith are similar in that each discloses wedge shaped corrective pads of rectangular configuration, a pad being secured, respectively, to the anterior and posterior portions of an insole and oriented such that each pad (and the tapered faces thereof) extend/face transversely of the longitudinal axis of the insole. Marc discloses a U-shaped heel element (20) that is similar to the cushion (19) of Kantro, the heel element (20) of Marc being inset into a like-shaped receiving cavity (11) in the foot element. The Marc and Kantro heel elements are angularly fixed and not rotatable. There is only one permitted orientation.

Applicant's Attorney submits that the Examiner has not properly followed the analysis required under 35 USC Section 103. The rejection is believed flawed because:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F. 2d 900, 1572, 1577, 221 USPQ 929, 933 (Fed. Cir 1984) Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritsch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992).

Further, the mere fact that the prior art may be modified by in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Here, Kantro and Cherniak relied upon by the Examiner fail to suggest any motivation for, or the desirability of the changes espoused by the Examiner. The Examiner then picks and chooses elements from Shaw, and Smith, and then Marc to form an obviousness rejection.

The Examiner has relied upon hindsight to arrive at the determination of obviousness. The Examiner has impermissibly used the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The CAFC has made clear that "[o]ne cannot pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). Accordingly, the Examiner's rejection based on a combination of Kantro, and Cherniak, and Shaw, and Smith, and March is believed contrary to the analysis required under 35 USC Section 103 and the rejection of the claims based on the above combination withdrawn.

Claims 7 – 8 are directed to balancing disc for balancing the gait of a user, and requires, inter alia,

a substantially rigid, circular, wedge member having a planar upper surface and a planar lower surface, the upper and lower surfaces being angularly inclined with respect to each other by an angle \emptyset of about 2° to about 6° the disc being attachable to a footwear item for imparting proper weight distribution and balance to the user.

Applicant's Attorney submits that the prior art does not teach the provision of a substantially rigid circular wedge-shaped member having an inclination range required in Claims 7 – 8.

Claims 7 – 8 require a substantially rigid circular wedge shaped disc. As discussed herein above, Kantro teaches the provision of cushions (19, 20, and 21), and Cherniak teaches pads of uniform thickness.


In Kantro, the cuboidal cushion (20) is shown (FIGS. 2, 3, and 5) as being circular and described as positioned "such that the taper is angled relative to the longitudinal axis of the insert". Importantly, the Figures and the Specification do not state and do not show a taper angle of the cushion (20). The only angle that can be determined with any degree of certainty is the angle of the cushion (20) relative to the longitudinal axis of the foot. Kantro is silent as to a preferred angle or range of angles.

The Examiner states:

"[D]isc/cushion 20 can also be angularly tapered through its thickness from its forward edge rearward with respect to each other as described at column 4, lines 14-49 and column 5, lines 37-41. Note that heel cushion/disc **19** is **tapered** at about 5 degrees. It is submitted the only reasonable conclusion (by comparison of column 4, line 32 to line 46) is that cushion **20** is also exactly **tapered** as described for cushion/disc 19."

Examiner's Final Action, lines 6 – 10 of Paragraph 8.

Applicant's Attorney strongly disagrees with the Examiner's contention as hindsight reasoning.

First, Kantro provides three cushions (19, 20, and 21) for three different gait points and arranges the cushions to form the vertices of an obtuse triangle. Each cushion has a **different geometry**, a **specific location**, a **specific orientation** relative to longitudinal axes through the insole, and a **different function**. The **cushions do not**  have the requisite geometry and the wedge shaped cushion (20) does not have the requisite angle of inclination.

Second, **the Examiner's conclusion that the two cushions (19 and 20) have exactly the same taper, and that the taper angle is 5° is nowhere found in or suggested by Kantro.** In Kantro, the heel cushion (19) is configured into a heel-shape for supporting the heel. Kantro teaches that heel cushion (19) is tapered through its thickness from its forward edge (19a) rearward, and that cuboidal cushion (20) is tapered along an axis at an angle relative to the longitudinal axis of the insole. Kantro does not state that the heel cushion (19) or the cuboidal cushion (20) be tapered at 5°. Indeed, Kantro does not state any range at all, or ^{or} that a range is desired – only that each cushion be appropriately oriented relative to the other two cushions (20 and 21). The Examiner's assertion that "the only reasonable conclusion is that cushion (20) is also exactly tapered as cushion (19) [at about 5°]" is pure hindsight reading of Kantro. The only reasonable conclusion is that Kantro is silent on this issue. There is absolutely no teaching or suggestion in Kantro for the Examiner's conclusion.

The other references are of interest but further corroborative of the use of hindsight reading to pick and choose from different apparatus angles to support a

rejection. The basic reference to Kantro and Cherniak do not show or suggest a disc as required by Claims 7 – 8. The secondary references to Smith, Shaw, and Marc are illustrative of picking and choosing that which is needed. While each apparatus may show an isolated structure that is tapered at a specific angle, these references do not show or suggest the requisite range as required in Claims 7 – 8.

Applicant's Attorney submits that Claims 7 – 8 are patentable over the prior art to Kantro and Cherniak, and/or in view of Shaw, and Smith, and Marc.

Conclusion

The Examiner's characterization of the Affidavit herein should be reversed as inappropriate and not consistent with the the Patent Office Rules of Practice.

The Examiner's rejection based on 35 USC 112, second paragraph, as being indefinite is believed flawed and should not be upheld. Reversal of this rejection is respectfully requested.

The prior art of record herein, whether considered in view of Kantro in view of Cherniak, alone or further in combination with Shaw, Smith, and Marc, does not show or suggest or render obvious (a) the balancing disc for securement to an orthotic foot device, as required by Claim 1, or (b) the balancing disc for balancing the gait of a user, as required by Claims 7 and 8.

The prior art does not provide a motivation for the combination(s) suggested by the Examiner.

The Examiner has not followed the analysis required by 35 USC 103 and has not presented a prima facie case from which a conclusion of obviousness can follow.

Applicant's Attorney submits that Claims 1, and 7 – 8 define patentably over the prior art, are allowable, and are in condition for allowance.

Accordingly it is respectfully requested that a Notice of Allowance be issued.

Respectfully submitted,



Charles D. Lacina
Attorney for Applicant
Registration No. 28,094
(248) 901 - 4000

PLUNKETT & COONEY, PC
38505 Woodward, Suite 3000
Bloomfield Hills, MI 48304

Dated: October 13, 2001

9. Appendix of Claims Involved in the Appeal

1. (AMENDED) A balancing disc for an orthotic foot device comprising:
a substantially circular member having a planar top surface and a planar bottom surface, the surfaces being inclined at an angle with respect to each other, the disc being securable to the orthotic foot device in a plurality of incremental orientations through 360° to effect a desired balance and weight distribution.

7. (AMENDED) A balancing disc for balancing the gait of a user, comprising:
a substantially rigid, circular, wedge member having a planar upper surface and a planar lower surface, the upper and lower surfaces being angularly inclined with respect to each other by an angle θ of about 2° to about 6° the disc being attachable to a footwear item for imparting proper weight distribution and balance to the user.

8. (AMENDED) The balancing disc of claim 7 wherein the disc is formed of a substantially non-compressible solid material selected from the group consisting of leather, rubber or plastic.